

REMARKS

Prior to this Amendment, claims 1-2, 5-8, 10-13 and 32-52 were pending in this application, of which claims 11 and 12 were withdrawn from consideration. By this Amendment, Applicants have amended claims 1, 6, 38 and 48 and cancelled claims 5, 7, 11 and 12 without prejudice or disclaimer of the subject matter recited therein.

Applicants do not acquiesce in the Examiner's rejections, but instead have elected to make the above-mentioned amendments in an effort to expedite prosecution of this application leading to issuance of a patent. Reconsideration of the application as amended above and in view of the following remarks is earnestly solicited.

CLAIM REJECTIONS**35 U.S.C. § 112, First Paragraph**

Claims 1-2, 5-8, 10-13 and 32-52 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. More particularly, the Examiner asserts that the specification is only enabled for a limited combination of the claimed adhesives and light absorbers.

By this present amendment, independent claims 1, 6 and 48 have been amended as shown in the Listing of Claims and are believed to be fully enabled. As such, Applicants respectfully request that the rejection of claims 1-2, 5-8, 10-13 and 32-52 under 35 U.S.C. §112, first paragraph be withdrawn.

35 U.S.C. § 112, Second Paragraph

Claim 13 is rejected under 35 U.S.C. § 112, second paragraph, as failing to provide adequate antecedent basis for the limitation "the green food coloring."

Independent claim 6, from which claim 13 depends, has been amended as shown in the Listing of Claims and is believed to provide the appropriate antecedent basis to support this limitation. As such, Applicants respectfully request that the rejection of claim 13 under 35 U.S.C. §112, second paragraph be withdrawn.

Claim Rejection under 35 U.S.C. § 102 – Pitts et al.

The Examiner rejected claims 1, 2 and 32-37 under 35 U.S.C. § 102(b) as being anticipated by the literature article "New Photoactivators for Multiphoton Excited Three-dimensional Submicron Cross-linking of Proteins: Bovine Serum Albumin and Type 1 Collagen" to Pitts et al., *Photochemistry and Photobiology*, 2002, 76(2) 135-144 ("Pitts").

However, Applicants respectfully submit that Pitts does not support the Examiner's rejection under § 102(b) in light of the amendments and arguments made in this response. More particularly, for a claim to be anticipated under 35 U.S.C. § 102, each and every limitation of the claim must be disclosed in a single prior art reference. General Electric Co. v. Nintendo Co., 50 USPQ2d 1910, 1915 (Fed. Cir. 1999). To anticipate a claim, a reference must disclose "every element of the challenged claims and enable one skilled in the art to make the anticipating subject matter" PPG Industries, Inc. v. Guardian Industries Corp., 37 USPQ2d 1618, 1624 (Fed. Cir. 1996). There can be no anticipation unless it is found that a single prior art reference has all of the same elements in "exactly the same situation and united in the same way." Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ (BNA) 669, 673 (Fed. Cir. 1984), citing Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ (BNA) 781, 789 (Fed. Cir. 1983).

Independent Claim 1

Applying the above legal standards to the present matter, Applicants respectfully contend that Pitts fails to meet the requirements needed to satisfy a *prima facie* case of anticipation under 35 U.S.C. § 102(b) by not disclosing "each and every" limitation of amended independent claim 1. More particularly, Pitts is directed to the use of rose Bengal derivatives to induce light activated cross-linking of collagen. However, Applicants find no teaching in Pitts of a composition suitable for medical and surgical applications comprising, *inter alia*, a biologically compatible scaffold material having at least one irregular surface and including one of small intestine submucosa or poly(L-lactic-co-glycolic acid) (PLGA), as specifically required by amended independent claim 1. As such, Pitts does not disclose each element of the claimed invention and thereby does not satisfy the anticipation standard set forth by § 102, which specifically requires that all of the claimed elements be found in "exactly the same situation and united in the same way" in a single prior art reference. Accordingly, the Examiner's rejection of amended independent claim 1 as being anticipated by Pitts should be withdrawn. Removal of the rejection and allowance of claim 1 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these claimed limitations are expressly disclosed within the teachings of Pitts.

Dependent Claims 2 and 32-37

Claims 2 and 32-37 each ultimately depend from independent claim 1. Since claim 1

is believed to be allowable for the reasons discussed above, claims 2 and 32-37 are also believed to be allowable. Removal of the rejection and allowance of claims 2 and 32-37 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where in the prior art the limitations of the dependent claims are expressly disclosed within Pitts.

Claim Rejection under 35 U.S.C. § 102 - Moser

The Examiner rejected claims 6, 8, 40 and 42-47 under 35 U.S.C. § 102(b) as being anticipated by the literature article "New Range of Light-Activated Surgical Adhesives for Tissue Repair" to Moser et al., *Biomed. Sci. Instrum.*, Vol. 37, pages 441-449, 2001 ("Moser"). However, Applicants respectfully submit that Moser does not support the Examiner's rejection under § 102(b) in light of the amendments and arguments made in this response.

Independent Claim 6

Moser fails to meet the requirements needed to satisfy a *prima facie* case of anticipation under 35 U.S.C. § 102(b) by not disclosing "each and every" limitation of amended independent claim 6. More particularly, Moser is directed to a surgical adhesive composed of a poly(L-lactic-co-glycolic acid) scaffold and doped with a traditional protein solder mix of bovine serum albumin and a chromophoric dye, such as indocyanine green dye (see generally, Moser's Abstract). However, Applicants find no teaching in Moser of a composition adaptable to repair biological tissue comprising, *inter alia*, light absorbers selected from at least one of red food coloring, blue food coloring and green food coloring, such as is specifically required by amended independent claim 6. As such, Moser does not disclose each element of the claimed invention and thereby does not satisfy the anticipation standard set forth by § 102, which specifically requires that all of the claimed elements be found in "exactly the same situation and united in the same way" in a single prior art reference. Accordingly, the Examiner's rejection of amended independent claim 6 as being anticipated by Moser under § 102(b) should be withdrawn. Removal of the rejection and allowance of claim 6 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where these claimed limitations are expressly disclosed within the teachings of Moser.

Dependent Claims 8, 40 and 42-47

Claims 8, 40 and 42-47 each ultimately depend from independent claim 6. Since

claim 6 is believed to be allowable for the reasons discussed above, claims 8, 40 and 42-47 are also believed to be allowable. Removal of the rejection and allowance of claims 8, 40 and 42-47 is respectfully requested. If the Examiner should disagree with the Applicants' arguments, the Examiner is asked to kindly point out with particularity where in the prior art the limitations of the dependent claims are expressly disclosed within Moser.

Claim Rejection under 35 U.S.C. § 103 – Moser


The Examiner has rejected claims 10 and 41 under 35 U.S.C. § 103(a) as being unpatentable over Moser.

Claim 6, from which claims 10 and 41 depend, is discussed in detail above, as are the deficiencies of Moser with respect to claim 6. As Applicants find no teaching in Moser of a composition adaptable to repair biological tissue comprising, *inter alia*, light absorbers selected from at least one of red food coloring, blue food coloring and green food coloring, one skilled in the relevant art would be unable to formulate the presently claimed compositions from the teachings of Moser. As such, it is submitted that the compositions defined by present claims 10 and 41 are nonobvious over and patently distinguishable from Moser, whereby the rejection under 35 U.S.C. § 103 has been overcome. Reconsideration is respectfully requested.

FINAL REMARKS

Applicants submit that the application is now in condition for allowance and respectfully request that the same be granted. Applicants request that, if necessary, this Amendment be considered a request for an extension of time for a time appropriate for the amendment to be timely filed. Applicants request that any required fees for filing this Amendment be charged to the account of Bose McKinney & Evans LLP, Deposit Account Number 02-3223.

Respectfully submitted,
BOSE McKINNEY & EVANS



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